

Application No. 10/709,688
Docket No. 13DV-14039-3
Amendment dated June 8, 2006
Reply to Office Action of April 5, 2006

REMARKS

In the Office Action, the Examiner reviewed claims 1-20 of the above-identified US Patent Application, with the result that independent claim 1 and its dependent claims 2, 3, 19, and 20 were rejected, independent claim 9 and its dependent claims 10-18 were allowed, and claims 4-8 (which depend from claim 1) were deemed to recite allowable subject matter.

In response, Applicants have amended independent claim 1 to incorporate all limitations of its dependent claim 20 (which has been canceled without prejudice to Applicants).

Applicants believe that the above amendments do not present new matter, and that the amendments strictly comply with 37 CFR §1.116(a) as being limited to reducing and simplifying the issues remaining in the examination of Applicants' application, namely, the cancellation of a dependent claim and incorporation of its subject matter into its parent claim.

Consequently, Applicants believe that the above amendments do not raise new issues that would require further consideration and/or search by the Examiner,

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and place the claims in better condition for appeal.¹

Favorable reconsideration and allowance of remaining claims 1-19 are respectfully requested in view of the above amendments and the following remarks.

Rejections under 35 USC §103

Independent claim 1 and its dependent claims 2, 3, 19, and 20 were rejected under 35 USC §102 and/or §103(a) in view of U.S. Patent No. 5,015,492 to Venkatesan et al. (Venkatesan) and U.S. Patent No. 4,676,994 to Demaray, alone or in combination with each other and U.S. Patent No. 5,849,371 to Beesley. Under these rejections, the Examiner cited passages from these references regarding teachings in which a shutter is initially used to

¹ MPEP §714.13 instructs:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely *cancels claims, adopts examiner suggestions, removes issues for appeal*, or in some other way *requires only a cursory review by the examiner*, compliance with the requirement of a showing under 37 CFR 1.116(b) is expected in all amendments after final rejection. (Emphasis added.)

MPEP 714.13 further instructs: "The refusal to enter the proposed [Rule 116] amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether *the issues on appeal are simplified*." (Emphasis added.)

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prevent a vapor cloud from contacting a substrate to be coated. However, the Examiner did not cite any of these references as being operable to perform the operation recited in dependent claim 20 and now incorporated into its parent claim 1, namely, positioning a preventing (shutter) means (36) between an evaporation source (10) and the component (30) following a subsequent (coating deposition) phase and during a second subsequent phase in which a remaining portion of the evaporation source (10) is relatively rich in certain oxide compounds (and therefore coating deposition is no longer desirable from a composition standpoint).


In view of the above, Applicants believe that the prior art does not disclose or suggest Applicants' apparatus as now recited in claim 1, and Applicants respectfully request withdrawal of the rejections to the claims under 35 USC §102 and §103.

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Closing

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

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